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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/401,839      09/22/99      GATELY      M      1803-247

020583      HM12/0124  
PENNIE AND EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK NY 10036-2711

EXAMINER

MERTZ, P

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

01/24/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/401,839

Applicant(s)

Gately et al.

Examiner

Prema Mertz

Group Art Unit

1646



☒ Responsive to communication(s) filed on Sep 22, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 33-38 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 33-38 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. Claims 1-32 have been canceled in Paper No. 2, 9/22/99. New claims 33-38 (Paper No. 2, 9/22/99), are under consideration.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2a. Claims 33-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Trinchieri et al. (US Patent No. 5,811,523).

Trinchieri et al teach both monoclonal and polyclonal antibodies to natural killer cell stimulatory factor (NKSF) (column 10, lines 25-28), said NKSF capable of inducing proliferation of PHA-activated peripheral blood lymphocytes (see column 2, lines 55-67). The amino acid sequences of the two sub-units of NKSF (Figure 1A-1D and Figure 2A-2C) are identical to the amino acid sequences of the sub-units of CLMF of the instant application. Trinchieri also teaches antibodies to each of the subunits of CLMF and antibodies to the mature protein subunits (see column 22, lines 41-52). Therefore, the disclosure of Trinchieri meets all the material limitations of claims 33-38 and clearly anticipates these claims.

#### ***Claim Rejections - 35 USC § 103***

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3a. Claims 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trinchieri et al. (U.S. Patent No. 5,811, 523).

Trinchieri et al. disclose the cDNA cloning and functional expression of natural killer cell stimulatory factor (NKSF) and the amino acid sequence of the factor which has 2 heterogenous subunits, said subunits having an amino acid sequence which is identical to the amino acid sequence of the subunits of CLMF of the instant application (see Figures 1 and 2). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the instant invention to use the protein

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subunits disclosed by Trinchieri, to produce monoclonal and polyclonal antibodies against NKSF, to facilitate the *in situ* detection of the NKSF protein in a biological sample.

4. Receipt of applicant's request under 37 CFR 1.607 and 1.608(a) for interference with US Patent No. 5, 811, 523 is acknowledged.

However, an interference between the instant application and US Patent No. 5, 811, 523 cannot be declared without a showing under 37 CFR 1.608(b) by means of a declaration or an affidavit to provoke an interference with a patent whose effective filing date antedates that of the instant application by more than 3 months.

#### ***Conclusion***

No claim is allowable

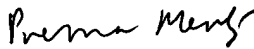
#### ***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
Prema Mertz Ph.D.  
Primary Examiner  
Art Unit 1646  
January 7, 2000